



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,575	10/15/2003	Michael J. Hafer	020375-039810US	7753

20350 7590 11/19/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,575

Applicant(s)

HAFER ET AL.

Examiner

Lalita M Hamilton

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08182004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Bam (US 2004/0083170).

Bam discloses a system and method of integrating loyalty/reward programs with payment identification systems comprising a transaction provider and a service provider, the transaction provider providing money transfer services for the customer and the customer having an account associated with a convenience card, a system for enhancing customer loyalty in money transfer transactions, the system comprising a communication network, the communication network being configured to transport information relating to the money transfer services provided by the transaction provider, a point of sale device in communication with the communication network, the point of sale device being located at a particular origination location and configured to receive an identifier, the identifier including sufficient identifying information to allow the transaction provider to identify the customer's account, to receive a request from the customer to process a money transfer transaction to a particular destination location,

Art Unit: 3624

and to transmit the identifier and the request to process a money transfer transaction and a transaction provider control in communication with the communication network and further in communication with a service provider, the transaction provider control being configured to receive the identifier and the request to process a money transfer transaction from the point of sale device, to identify the customer's account based on the identifying information included in the identifier, and to credit the customer's account with an award associated with the request to process a money transfer transaction, the award being redeemable by the customer for credit toward the purchase of a product from the service provider (p.2, 12-13 and p.4, 33-35); the point of sale device is further configured to receive the identifier by reading the identifier from the convenience card as the convenience card is swiped through the point of sale device (p.3, 28-29); the identifier is a telephone number (p.3, 29); the service provider is a merchant, and wherein the product is a tangible good (p.4, 33-34); the service provider is a telecommunication service provider, and wherein the product is a telecommunication service (p.4, 33-34—It is inherent that any provider or product may be used); the award credited to the customer's account by the transaction provider control comprises sufficient credit to allow the customer to place a telephone call of a certain duration from the particular origination location to the particular destination location (p.4, 33-34); the transaction provider control comprises a database, which includes information about the customer's account (fig.1, 14 and p.3, 31 to p.4, 33); the transaction provider control is further configured to update the second account with information related to the money transfer transaction (fig.1, 14 and p.3, 31 to p.4, 33); the service provider comprises a

Art Unit: 3624

service provider control in communication with the transaction provider control, the service provider control comprising a database, which includes information about the customer's account (fig.1, 17 and p.3, 30); the customer's account is maintained by the transaction provider (fig.1, 14 and p.3, 31 to p.4, 33); the customer's account is maintained by the service provider (fig.1, 17 and p.3, 30); crediting the customer's account with an award comprises sending a message to the service provider, the message including sufficient information to indicate the amount of the credit to be awarded to the customer's account (p.4, 34-35); the message specifies the amount of credit to be awarded to the customer's account (p.4, 34-35); the message includes sufficient information about the money transfer transaction to allow the service provider to determine the amount of credit to be awarded to the customer's account (p.4, 34-35); the message comprises information about the particular destination location and the particular origination location (p.4, 34-35); the customer's account is a first account, and wherein the convenience card is further associated with a second account maintained by the transaction provider (p.4, 34-35); the transaction provider control is further configured to update the second account with information related to the money transfer transaction (p.4, 34-35); the particular origination location and the particular destination location are the same location (p.4, 34-35—i.e. could be same bank); the award is based on a determinant selected from the group consisting of the amount of the money transfer transaction, the originating location of the money transfer transaction, the destination location of the money transfer transaction, the timing of the money transfer transaction, an amount of a service fee associated with the money transfer transaction,

Art Unit: 3624

and a type of money transfer transaction requested (p.4, 34-35); a transaction provider control in communication with a third-party service provider, a point of sale device in communication with the transaction provider control, wherein the point of sale device comprises a processor and a storage medium, and wherein the storage medium includes instructions executable by the processor to receive an identifier associated with a convenience card, wherein the convenience card is associated with an account at the service provider, receive a request for a money transfer transaction, and transmit the money transfer transaction request to the transaction provider control for execution (p.2, 12-13 and p.4, 33-35); comprises a second processor and a second storage medium, and wherein the second storage medium includes instructions executable by the second processor to receive a money transfer transaction request from the point of sale device; receive the identifier from the point of sale device, associate the money transfer transaction with the identifier, and transmit a request to the third-party service provider to add credit to the service provider account associated with the convenience card, wherein the credit is based at least in part on the money transfer transaction (p.4, 33-35); a third storage medium, the third storage medium comprising a database including a transaction provider account associated with the convenience card, and wherein the second storage medium includes instructions executable by the second processor to update the transaction provider account with information related to the requested money transfer transaction (p.4, 33-35); a money transfer convenience card that can be used to facilitate a money transfer through a transaction provider, wherein the money transfer convenience card is associated with an account, such that when the money transfer

Art Unit: 3624

convenience card is used to facilitate a money transfer transaction through the transaction provider, an award is credited to the account associated with the convenience card, the award being redeemable toward the purchase of a product from a service provider and being based at least in part on the money transfer transaction (p.4, 33-35); in a relationship between a customer, a transaction provider and a service provider, the transaction provider providing money transfer services for the customer and the customer having an account, the account being associated with a convenience card, a method for enhancing customer loyalty in money transfer transactions, the method comprising receiving a request from a customer to process a money transfer transaction, wherein the money transfer transaction has a certain origination location and a certain destination location, receiving an identifier, the identifier including sufficient identifying information to allow the customer's account to be identified, identifying the customer's account based on the identifying information included in the identifier, and crediting an account with an award based at least in part upon the requested money transfer transaction, the award being redeemable by the customer for credit toward the purchase of a product from a service provider (p.2, 12-13 and p.4, 33-35); receiving an identifier associated with a money-transfer convenience card, wherein the money-transfer convenience card is associated with an account at a third-party service provider, processing a money transfer transaction, associating the money transfer transaction with the identifier, and adding credit to the account at the third-party service provider, wherein the credit is based at least in part on the money transfer transaction (p.2, 12-13 and p.4, 33-35); in a relationship between a customer, a

Art Unit: 3624

transaction provider and a service provider, the transaction provider providing money transfer services for the customer and the customer having an account, the account being associated with a convenience card, a method for enhancing customer loyalty in money transfer transactions, the method comprising receiving at a point of sale device an identifier from a convenience card, the identifier including sufficient identifying information to allow the transaction provider to identify the customer's account, the point of sale device being situated at a particular origination location, receiving at the point of sale device a request from the customer to process a money transfer transaction to a particular destination location, transmitting via a communication network the identifier and the request to process a money transfer transaction, receiving at a transaction provider control the identifier and the request to process a money transfer transaction; identifying the customer's account based on the identifying information included in the identifier, calculating an amount of prepaid telephone service credit sufficient to allow the customer to place a telephone call of a certain duration from the origination location to the destination location, such that the customer can call a receiving party near the destination location to inform the receiving party that the customer has placed a request to process a money transfer transaction to the destination location, and crediting the customer's account with an award, the award being equivalent to the calculated amount of prepaid telephone service credit and based at least in part on the request to process a money transfer transaction (p.2, 12-13 and p.4, 33-35); in a relationship between a customer, a transaction provider and a service provider, the transaction provider providing money transfer services for the customer and the customer having an

Art Unit: 3624

account, the account being associated with a convenience card, a system for enhancing customer loyalty in money transfer transactions, the system comprising a communication network, the communication network being configured to transport information relating to the money transfer services being provided by the transaction provider, means for receiving an identifier from the convenience card, the identifier including sufficient identifying information to allow the transaction provider to identify the customer's account with the transaction provider, the means for receiving an identifier from the convenience card being situated at a particular origination location, means for receiving a request from the customer to process a money transfer transaction to a particular destination location, means for transmitting via the communication network the identifier and the request to process a money transfer transaction, means for receiving via the communication network the identifier and the request to process a money transfer transaction, means for identifying the customer's account based on the identifying information included in the identifier, means for calculating an amount of prepaid telephone service credit sufficient to allow the customer to place a telephone call of a certain duration from the origination location to the destination location, such that the customer can call a receiving party near the destination location to inform the receiving party that the customer has placed a request to process a money transfer transaction to the destination location, and means for crediting the customer's account with an award, the award being equivalent to the calculated amount of prepaid telephone service credit and based at least in part on the request to process a money transfer transaction (p.2, 12-13 and p.4, 33-35); in a relationship between a customer, a

Art Unit: 3624

transaction provider and a service provider, the transaction provider providing money transfer services for the customer and the customer having an account, the account being associated with a convenience card, a system for enhancing customer loyalty in money transfer transactions, the system comprising a communication interface, a processor in communication with the communication interface, and a computer readable medium in communication with the processor, the computer readable medium comprising instructions executable by the processor to receive an identifier associated with an account, receive a request to process a money transfer transaction, process the money transfer transaction, and credit the account with an award based at least in part upon the requested money transfer transaction, the award being redeemable by the customer for credit toward the purchase of a product from a service provider (p.2, 12-13 and p.4, 33-35); and in a relationship between a customer, a transaction provider and a service provider, the transaction provider providing money transfer services for the customer and the customer having an account, the account being associated with a convenience card, a system for enhancing customer loyalty in money transfer transactions, the system comprising a communication interface, a processor in communication with the communication interface, and a computer readable medium in communication with the processor, the computer readable medium comprising instructions executable by the processor to receive from a point of sale device an identifier associated with a convenience card, the identifier including sufficient identifying information to allow the transaction provider to identify the customer's account, receive from a point of sale device a request from the customer to process a

Art Unit: 3624

money transfer transaction from a particular origination location to a particular destination location, identify the customer's account based on the identifying information included in the identifier, calculate an amount of prepaid telephone service credit sufficient to allow the customer to place a telephone call of a certain duration from the origination location to the destination location, such that the customer can call a receiving party near the destination location to inform the receiving party that the customer has placed a request to process a money transfer transaction to the destination location, and credit the customer's account with an award, the award being equivalent to the calculated amount of prepaid telephone service credit and based at least in part on the request to process a money transfer transaction (p.2, 12-13 and p.4, 33-35).

Provisional Application Listed on PTO-892 form

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the

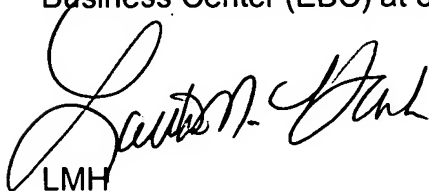
provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH